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In re Application of
Ulrich Klar et al
Serial No.: 09/485,292
Filed: May 3, 2000
Attorney Docket No.: Sch-1742

PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed July 31, 2007, requesting withdrawal of a Notice of unacceptable Appeal Brief mailed June 26, 2007.

BACKGROUND

A review of the file history shows that a first examiner mailed a first Office action to applicants on April 10, 2001, and remailed the action on December 12, 2001, setting forth a restriction requirement and an election of species requirement in this application which was filed under 35 U.S.C. 371. Applicants elected a single species from claim 8, as requested, on June 12, 2002. Prosecution continued with the mailing of a non-Final Office action on August 27, 2002, with further responses and Office actions following. At some point in the prosecution the original election of species was redesignated as a restriction requirement.

Following filing of RCE papers and a new non-Final Office action and response, a Final Office action was mailed to applicants on April 28, 2006, to which a response was filed on August 4, 2006. In view of the response, the finality of the previous Office action was withdrawn and a new Final Office action was mailed to applicants on September 14, 2006. Applicants filed a Notice of Appeal on December 14, 2006 and an appropriate Appeal Brief on February 23, 2007.

On June 26, 2007, the examiner mailed a Notice of unacceptable Appeal Brief to applicants stating that the Brief was unacceptable because the claims contain subject matter which is not appealable. The examiner then notes that the claims were subject to a restriction requirement and still contain subject matter which has been withdrawn and not examined. The examiner also refers to an affidavit under 37 CFR 1.132 supplied with the Appeal Brief which is indicated as

not being commensurate with the scope of the claims (since they contain non-elected subject matter). The examiner then indicates the Appeal will be dismissed if applicants do not amend the claims to the scope being examined.

Applicants filed this petition on July 31, 2007, objecting to the Notice and questioning whether the examiner has authority to dismiss an Appeal on such grounds.

DISCUSSION

Applicants request withdrawal of the examiner's letter on June 26, 2007, and the requirements thereof.

Applicants note that an original restriction and election of species was set forth and responded to in an appropriate manner with the claims of Group I being elected and claims to the other groups being canceled. No traverse of the requirement was made. Subsequently the examiner made a further purported restriction requirement within the claims of the elected Group. Applicants indicate that an objection to this requirement was made, but no petition has been filed regarding it.

It should be noted that this application is a National Stage Entry under 35 U.S.C. 371. As such restriction of the claims is improper. However, a finding of Lack of Unity may be or have been appropriate. Lack of Unity guidelines do not permit or provide for election of species requirements, although an examiner may seek guidance from applicants as to what species would be an appropriate starting point for search and examination of a large Markush group. In any event, applicants and the examiner have reached a point in prosecution where the claims contain examined subject matter and unexamined subject matter as defined by the effected election of species.

The examiner has objected to the claims in the Appeal Brief, and has made similar objections in past Office actions, as containing non-elected subject matter. For this reason alone the examiner holds the Appeal Brief unacceptable. The Appeal Brief is proper in all other aspects and is directed to the rejection of the elected species as set forth by the examiner in the Final Office action.

A review of guidelines governing Appeal Briefs shows no prohibition of claims which contain non-elected subject matter or withdrawn subject matter being included in the Appendix of Claims attached to the Appeal Brief. It is presumed that even in situations where the non-elected subject matter is within a claim which also contains elected subject matter on which the Appeal is based that the Board of Patent Appeals and Interferences can discern between the two and provide a decision appropriate to the elected subject matter.

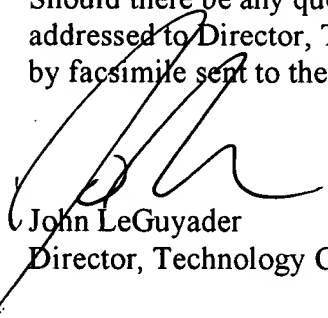
The examiner states that applicants must maintain a clear line of demarcation between appealable and petitionable subject matter. Applicants have done so and directed their Brief only to appealable subject matter. No petition of the restriction or election of species requirement has been filed, nor is required to be filed.

DECISION

The petition is **GRANTED**. The examiner's letter mailed June 26, 2007, is hereby vacated.

The application will be forwarded to the examiner for consideration of the Appeal Brief and appropriate action thereon.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



John LeGuyader
Director, Technology Center 1600